

Remarks35 U.S.C. § 102 Claim Rejections

Claims 1-7, 9, and 10 and 12-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark et al. (U.S. Patent No. 5,853,846). The Examiner alleges that "Clark et al. discloses forming an array of magnet pavement elements (6) interconnected by a carrier web (4, 12, 21)." The Examiner further alleges, "The connection between elements (Figure 5, for example) is frangible."

Claim 1 recites:

"A method of making a magnetic pavement marker comprising the steps of:

forming an array of magnetic pavement elements interconnected by a carrier web; and

forming a frangible connection between the magnetic pavement elements and the carrier web."

As described beginning at p. 12, line 9, Figure 1 is a side sectional view of a magnetic pavement marker having an array 20 of magnetic pavement elements in accordance with a first embodiment of the present invention. The array 20 includes a plurality of magnetic pavement elements 24 and an integrally formed carrier web 22. In the illustrated embodiment, the magnetic pavement elements 24 comprise a permanently magnetizable material 25 dispersed in a binder 27. In the embodiment illustrated in Figures 1 and 2, the magnetic pavement elements 24 and the carrier web 22 are formed from the same material. A frangible connection 32 is formed around a perimeter of the magnetic pavement elements 24, typically by die cutting, so that the carrier web 22 can be removed after installation. The frangible connection 32 preferably has sufficient strength to releasably connect the magnetic pavement elements 24 and carrier web 22 until the array 20 is applied to a pavement surface 42 (see Figure 2).

Although Figure 1 is similar to Figure 5 of Clark et al. (U.S. Patent No. 5,853,846) in some aspects, it is clear that Figure 5 lacks "a frangible connection between the magnetic pavement elements and the carrier web".

Claims 1-5 and 6-20 are rejected under 35 U.S.C. (e) as being anticipated by Dahlin et al. (U.S. Patent No. 6,468,678).

The Applicant would like to bring to the attention of the Examiner, that corresponding WO 96/16231 published 30 May 1996. Assuming, however, that the same rejection would be made by the Examiner under 35 U.S.C. 102 (b), the Applicant submits that Dahlin et al., also fails to disclose a frangible connection between the magnetic pavements elements and the carrier web.

35 U.S.C. § 103 Claim Rejections

Claims 8 and 11 are rejected under 35 U.S.C. 103 (a) are being unpatentable over Clark et al as applied with respect to the previously stated 35 U.S.C. § 102 claim rejections, and further in view of Ryan et al. (U.S. Patent No. 4,123,140). The Examiner alleges that Ryan et al. teaches cutting a paving element formed on a carrier web.

The Applicant submits that since Clark et al. fails to teach a frangible connection between the magnetic pavements elements and the carrier web in the first place, there is not motivation for combining Clark et al. with Ryan et al. The Applicant requests that if this rejection is maintained by the Examiner that the Examiner provide further information regarding the specific teachings of Ryan et al. relied upon in support of this rejection.

Claim 6 is rejected under 35 U.S.C. 103 (a) are being unpatentable over Dahlin et al, in view of Clark et al. as applied with respect to the previously stated 35 U.S.C. § 102 claim rejections.

The Applicant reiterates that neither reference teaches a frangible connection between the magnetic pavements elements and the carrier web.

Reconsideration and a timely allowance is respectfully requested.

Respectfully submitted,

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Date

By: Carolyn A. Fischer
Carolyn A. Fischer, Reg. No.: 39,091
Telephone No.: (651) 575-3915

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833